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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/242,210	11/04/1999	LINDA V GRAVELL	E-731	9775

7590 11/19/2001

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EXAMINER

SOUGH, HYUNG SUB

ART UNIT PAPER NUMBER

2161

DATE MAILED: 11/19/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/242,210

Applicant(s)

Gravell et al.

Examiner

First Last

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1234



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2-4 & 8
- 18) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

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***Information Disclosure Statement***

1. A copy of "IBIP Host Specification" listed in the paper no. 8 is incomplete. Thus, the information referred to therein have not been considered as to the merits. However, U.S. patents cited in the specification have been considered and included PTO FORM 892 (Paper No. 9).

***Specification***

2. This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.

3. The disclosure is objected to because of the following informalities:

- Page 5, line 6, "5,454,3,038" cannot be understood.
- Page 19, line 9, should "3" be --30--?

**Applicant is advised to carefully review the entire specification for further needed corrections.**

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who

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has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

5. Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Kara (US PAT. 5,822,739).

Kara discloses a method for evidencing postage on a mailpiece comprising the steps of:

receiving at a data center postal information relating to a mailpiece, said postal information including recipient address information for the mailpiece (col. 6, lines 34-38; col. 8, lines 24-29);

generating a digital token for the mailpiece, said digital token including encrypted information for the mailpiece based on said recipient address information (col. 8, lines 24-29; col. 14, lines 25-67);

creating a transaction record, said transaction record including the digital the token and the postal information (col. 14, lines 29-36);

signing the transaction record (col. 14, lines 30-36; i.e., a transaction record having “a unique transaction identifier”);

storing the transaction record in a database (col. 14, lines 12-24); and

performing value added services using the transaction record (col. 14, lines 39-41).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 2 is rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Kara.

Kara discloses a system for dispensing postage value, comprising:

a data center (col. 3, lines 64-67) communicatively coupled to a plurality of remote processors, said remote processors initiating requests to the data center for dispensing postage value to be printed by a printer controlled by the remote processor (col. 3, lines 7-15; col. 7, lines 37-41), the data center comprising:

means for (see 103 in FIG.1) communicating with the remote processors, said communicating means receiving said requests for dispensing postage value (see 303 in FIG. 3);

means coupled to the communicating means for storing data records, said data records including user account information and meter account information associated with a plurality of users of user's accessing the data center through said remote processors (col. 14, lines 12-24); and

means coupled to the communicating means and the storing means for metering using said user account information and said meter account information (col. 14, lines 12-24).

Thus, Kara does not explicitly disclose means coupled to the communicating means, the storing means and the metering means for performing administrative functions within the data center.

However, the disclosure of Kara using means for communicating, means for storing data record,

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and means for metering implies that the Meter program of Kara either may have or would inherently have means for performing administrative functions coupled to the communicating means, the storing means and the metering means. The Examiner is not in a position to make either a conclusion of “inherently/anticipation” or “obviousness” since the record does not allow one to determine if and how the claimed subject matter differs from the prior art. Accordingly, the burden shifts to applicant to provide evidence that the prior art would neither anticipate nor render obvious the claimed invention. *In re Best* 195 USPQ 430,433 (CCPA 1977)

8. Claims 3-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kara.

**Re claim 3:** Kara does not explicitly disclose that the communicating means includes a communication server, the storage means includes a database server, the means for performing administrative functions includes a function server, and said metering means includes a secure meter box. However, it is well known in the art to employ servers (i.e., software programs, data storage server, and a secure meter box) for a computer system to facilitate the function of the system and it would have been within the level of ordinary skill in the art to employ the claimed servers and box to the system of Kara to facilitate the function of the system and to prevent fraudulent usage of the system.

**Re claim 4:** Kara does not explicitly disclose that each user has at least one meter account, each said meter account being assigned to one of the users accessing the data center. However, it is well known in the art to employ one meter account, each said meter account being assigned to one of the users accessing the data center for a postage system to facilitate the billing

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process and it would have been within the level of ordinary skill in the art to employ the meter to the system of Kara to facilitate the billing process.

**Re claim 5:** Kara does not explicitly disclose said secure meter box and said function server control the dispensing of postage value from each said meter account. However, Kara discloses that the Meter program controls the dispensing of postage value and it would have been within the level of ordinary skill in the art to use any server or servers as desired and secure meter box as desired to prevent fraudulent use of the system.

**Re claim 6:** Kara does not explicitly disclose that said administrative functions include creating and signing transaction records which are stored at said database server, each of said records corresponding to each postage dispensing transaction. However, Kara discloses that the Meter program creates and signs transaction records which are stored at said database server (col. 14, lines 12-54). Thus, it would have been within the level of ordinary skill in the art to use any server or servers to create and sign transaction records which are stored at said database server including the administrative server as desired. Further, each of said records must correspond to each postage dispensing transaction to keep track of available postage credit in the storage server.

**Re claim 7:** Kara does not explicitly disclose that said function server provides value added services, said value-added services including on-line rating, special mail services, address cleansing and postal coding services. However, Kara states that the Meter program can determine the amount of postage by utilizing information within the demand (col. 13, lines 58-60) and validates the correct address (col. 8, lines 25-29). Further, special mail services, address cleansing

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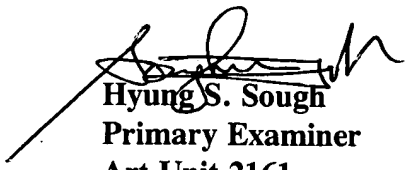
and postal coding services are well-known services provided by a postal system and it would have been within the level of ordinary skill in the art to provide these well-known services by using any desirable servers including the function server to facilitate the function of the claimed system.

**Re claim 8:** Kara does not explicitly disclose that said administrative functions include performing on-line track of all postal transaction processed by the data center. However, Kara discloses that the Meter program performs on-line track of all postal transaction processed by the data center (see FIG. 3) and it would have been within the level of ordinary skill in the art to employ any server in the Meter program including the administrative function server as desired.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hyung S. Sough whose telephone number is (703) 308-0505. The Examiner can normally be reached Monday-Friday from 8:30 AM - 4:00 PM EST.

If attempts to reach the Examiner by telephone are unsuccessful, The Examiner's Supervisor, James P. Trammell, can be reached on (703) 305-9768.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)305-3900. The Group Fax numbers are (703) 746-7238 for After-final, (703) 746-7239 for Official, and (703) 746-7240 for Non-Official/Draft.



Hyung S. Sough  
Primary Examiner  
Art Unit 2161

shs  
November 15, 2001